

Serial No. 09/892,732

REMARKS

In the Office Action the Examiner noted that claims 1-12, 14, and 15 are pending in the application, and the Examiner rejected all claims. By this Amendment, claims 1-2, 9-12, and 14-15 have been amended. No new matter has been presented. Thus, claims 1-12 and 14-15 remain pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Objection To the Specification

In item 2 on page 2 of the Office Action the Examiner alleged that a substitute specification in proper idiomatic English and in compliance with 37 C.F.R. §1.52(a) is required. The Examiner alleged that phrases such as "administering status of users" are not meaningful English.

The Applicants respectfully traverse this allegation by the Examiner. Regarding the objection to the specification and the substitute specification requirements, 37 CFR 1.125(a) provides that a substitute specification might be required "[i]f the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application" However, it is apparently not the claim amendments that the Examiner is alleging as the cause for requesting a substitute specification, as the Examiner merely cites examples of language that has not changed before the current Office Action. Further, the Applicants respectfully submit that it is improper to introduce such allegations in the sixth Office Action issued in the prosecution of this application. It would seem that the specification is sufficiently understandable that all of the previous actions were issued without such need. Finally, the phrasing cited by the Examiner, "administering status of users", would be easily understood by one skilled in the art. While perhaps not in the proverbial perfect Queen's English, it is respectfully submitted that the language is in proper idiomatic English sentences and is readily understood by those skilled in the art. In other words, the specification is not difficult to consider, and the onerous requirement of a substitute specification for such a lengthy application at this state of prosecution is highly improper.

Therefore, the Applicants respectfully submit that a substitute specification requirement is not appropriate, and further respectfully request reconsideration and withdrawal of the objection in view of these remarks.

Serial No. 09/892,732

Claim Rejections Under 35 USC §112

In item 5 on pages 2-3 of the Office Action the Examiner rejected claims 1-9, 11-12, and 14-15 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner cited various examples of claim language as being allegedly improper.

By this Amendment, claims 1-2, 9-12, and 14-15 have been amended and no longer include the language in the form rejected by the Examiner. Further, claims 3-8 depend from claim 2. Therefore, the Applicants respectfully request the withdrawal of the Examiner's §112, second paragraph rejections of claims 1-9, 11-12, and 14-15.

Claim Rejections Under 35 USC §103

In item 8 on pages 3-7 of the Office Action the Examiner rejected claims 1-4, 9-10, 12, and 14-15 under 35 U.S.C. §103(a) as being unpatentable over Recommend-it.com, a set of three documents (hereinafter referred to as "Recommend") in view of U.S. Patent Application Publication No. 2002/0026353, issued to Porat et al. (hereinafter referred to as "Porat"). The Applicants respectfully traverse the Examiner's rejections of these claims.

Claim 1 of the present application, as amended, recites displaying the status of the first user on the second computer, said status represented by advertising image data included in one of the at least two items of first advertising information broadcast, and displaying image data of the at least two items of first advertising information in a separate area, said displaying occurring in response to browsing by said first computer. In other words, one of the items of advertising information is displayed as status information of a user, and that item of advertising information is also displayed along with another one or more items of advertising information in another display area. The Applicants respectfully submit that none of the cited references, taken either alone or together, disclose at least these features of claim 1.

Recommend merely transmits a website that a user is viewing to another user, the first user having specified it as recommendation information. In other words, the information itself is notified to the second user. This is in direct contrast with an example embodiment enabled by the recited features of claim 1, wherein a plurality of items of advertisement information, all stored in correlation with a resource, are distributed and displayed to a user when another user accesses that resource, and one of the items of advertisement information is used to indicate status information of the accessing user. By making it possible to display a plurality of

Serial No. 09/892,732

advertisements at the user end to which the advertisements were transmitted, both an advertisement for something like a store, and an advertisement for a recommended product from that or other stores, can be presented to the receiving user. The amended language of claim 1 is supported at least on pages 36 through 38 of the specification, and illustrated at least in Figure 11 of the present application. If the user of such an embodiment views the advertisement and is interested in the displayed product, she can directly access the product information by clicking the image data of the product. If she wishes to view other products, she can view the other products by clicking the image data of the store and accessing same.

In even the broadest interpretation of Recommend as being similar to the method of claim 1, only an icon of something such as a shopping mall would be notified to the user, not recommended product information of products for sale at the shopping mall.

The Applicants respectfully note that the discussion of the example embodiments in the preceding paragraphs merely serves to illustrate some of the differences between the features of claim 1 and the cited references. However, the Applicants are not relying on the discussed features of the example embodiments as being patentably distinguishable over the cited references. Rather, the Applicants respectfully submit that the actual recited features of "displaying the status of the first user on the second computer, said status represented by advertising image data included in one of the at least two items of first advertising information broadcast, and displaying image data of the at least two items of first advertising information in a separate area, said displaying occurring in response to browsing by said first computer" are not disclosed, suggested, nor contemplated by the cited references.

Also, the Examiner acknowledged that Recommend does not disclose the broadcasting being performed in response to a status request by the second user. The Examiner went on, however, to equate adding a second user to a buddy list of a first user to that recited feature. The Applicants respectfully submit that this is not a proper characterization of the recited feature, for the discussed buddy list is in no way related to the recited status request. Therefore, there is no requisite motivation for any such modification. Despite any recent rulings relaxing the burden of the Examiner regarding identifying motivation for modifications used as a basis for obviousness rejections, there still exists the basic requirement of some motivation. The Applicants respectfully submit that this is lacking in the cited references.

Therefore, Recommend-it does not disclose at least the features of claim 1 discussed above. Further, as Porat apparently merely discloses sending buddy emails recommending a particular page which then includes a plurality of image data, Porat does not cure the

Serial No. 09/892,732

deficiencies of Recommend-it in regard to claim 1. Therefore, it is respectfully submitted that claim 1 patentably distinguishes over the cited references.

Claims 2, 9-10, 12, and 14-15, as amended, all recite similar features to those discussed in regard to claim 1, and which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claims 2, 9-10, 12, and 14-15 also patentably distinguish over the cited references.

Claims 3-4 depend from claim 2 and include all of the features of that claim plus additional features which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claims 3-4 also patentably distinguish over the cited references.

In item 9 on page 7 of the Office Action the Examiner rejected claims 5-8 under 35 U.S.C. §103(a) as being unpatentable over Recommend and Porat in view of U.S. Patent No. 5,794,210, issued to Goldhaber et al. (hereinafter referred to as "Goldhaber"). The Applicants respectfully traverse the Examiner's rejections of these claims.

As previously discussed in this Amendment, claim 2 patentably distinguishes over Recommend-it and Porat. Further, as Goldhaber apparently merely discloses doling out awards based on access to ads, Goldhaber does not cure the deficiencies of Recommend-it and Porat regarding claim 2 of the present application. Therefore, as claims 5-8 depend from claim 2 and include all of the features of that claim plus additional features which are not disclosed by the cited references, it is respectfully submitted that claims 5-8 also patentably distinguish over the cited references.

In item 10 on pages 7-9 of the Office Action the Examiner rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No.2006/0184886, issued to Chung et al. (hereinafter referred to as "Chung") in view of Goldhaber. The Applicants respectfully traverse the Examiner's rejections of this claim.

Claim 11 of the present application, as amended, recites similar features to those discussed above in regard to claim 1 of the present application, and which are not disclosed or suggested by cited references. Further, as Chung apparently merely discloses sending an advertisement to a second user, and not the dual display of any such advertisement as discussed in regard to claims 1 or 11, Chung does not cure the deficiencies of the cited references in regard to claims 1 or 11. Therefore, it is respectfully submitted that claim 11 also patentably distinguishes over the cited references.

Serial No. 09/892,732

Summary

In accordance with the foregoing, claims 1-2, 9-12, and 14-15 have been amended. No new matter has been presented. Thus, claims 1-12 and 14-15 remain pending in the application.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: February 21, 2008

By: Thomas L. Jones
Thomas L. Jones
Registration No. 53,908

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

CERTIFICATE OF FAXIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450
on 02/21/08
STAAS & HALSEY
By: Thomas L. Jones
Date: 02/21/08